

REMARKS

The present application relates to hybrid maize plant and seed 39W54. Claims 1-42 are currently pending in the present application. Applicant respectfully requests consideration of the following remarks.

Detailed Action

A. Status of the Application

Applicant acknowledges the indefiniteness rejection and the art rejection of record of claims 10, 14, 18, 23, 27 and 31 as overcome.

B. Deposit Statement

Applicant submits the Deposit section has been amended in order to properly include both the hybrid maize plant 39W54 and the inbred parents (GE533274 x GE533275) x GE492318 within the Deposit paragraph on page 40. The changes do not add new matter as there is literal support for the minor changes on page 7 in the originally filed specification. The specification has now been amended to correct these minor changes.

In addition, Applicant submits that at least 2500 seeds of hybrid maize plant 39W54 and inbred parent plants (GE533274 x GE533275) x GE492318 have been deposited with the ATCC on May 3, 2002 and May 6, 2002, respectively. In view of these deposits, the rejections under 35 U.S.C. § 112, first paragraph should be removed (MPEP § 2411.02). Such action is respectfully requested.

C. Specification

Applicant has amended the specification to correct an inadvertent error in the originally filed specification. Applicant respectfully submits that hybrid 39W54 is a three way cross and not a single cross as inadvertently stated in the specification. Applicant submits that (GE533274 x GE533275) is made in the field. The seed from this cross makes GE541031. Applicant submits then GE541031 is crossed with GE492318 whereby the seed from this cross is the hybrid 39W54. Applicant apologizes for this inadvertent error. Applicant submits the changes do not add new matter as there is literal support for the minor changes on pages 7 and 40 in the originally filed specification.

Rejections under 35 U.S.C. § 112, Second Paragraph

Claims 8, 11-19, 21, 24-33, 39 and 42 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, as stated in the last Office Action for claims 5-8, 10-19, 21 and 23-32.

Applicant has now canceled claims 8, 11-19, 21, 24-33 and 39, thus alleviating this rejection. Further, in an effort to expedite prosecution Applicant has amended claim 42 to read --A male sterile maize plant produced by the method of claim 41--, as suggested by the Examiner. Applicant thanks the Examiner for the suggested language.

Claim 33 stands rejected as indefinite in its recitation of "crossing an inbred maize plant (GE541031 x GE533274 x GE533275)" as confusing in its designation of a triple cross as an inbred maize plant.

Applicant respectfully traverses this rejection. As stated on page 7 of the specification hybrid maize plant 39W54 is produced by the crossing of four proprietary inbred maize lines. Inbred parent number 1 is a combination of GE533274 x GE533275 with the second inbred parent being GE492318. Applicant respectfully submits that one ordinarily skilled in the art would not find this recitation indefinite. In addition, Applicant has now amended the claims and the specification to include the proper ATCC accession numbers for the inbred parents. Further Applicant has also amended the Deposits paragraph on page 40 to further include the inbred maize plants. Therefore Applicant respectfully requests withdrawal of this rejection. However, in an effort to expedite prosecution, claim 33 has now been canceled, alleviating this rejection.

The Examiner rejects claim 39 as indefinite in its recitation of "A 39W54 maize plant...deriving at least 50% of its alleles from 39W54" as confusing.

Applicant has now canceled claim 39, thereby alleviating this rejection.

Claim 42 stands rejected as indefinite for failing to further limit claim 41.

Applicant has now amended claim 42 to be rewritten as follows: --A male sterile maize plant produced by the method of claim 41--, as suggested by the Examiner, thus alleviating this rejection.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 11, 15, 19, 24, 28, 32, 34 and 38-40 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has canceled claims 11, 15, 19, 24, 28, 32, 34 and 38-40, thus alleviating this rejection.

Claim 33 stands rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner states the deposit conditions for the recited four parental lines is unclear.

Applicant respectfully traverses this rejection. Applicant herein submits the Deposits section has been amended in order to properly include both the hybrid maize plant 39W54 and the inbred parents (GE533274 x GE533275) x GE492318 within the deposit paragraph. The changes do not add new matter as there is literal support for the minor changes on page 7 in the originally filed specification. The Applicant provides assurance that:

- a) during the pendency of this application access to the invention will be afforded to the Commissioner upon request;
- b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;
- c) the deposit will be maintained in a public depository for a period of thirty years, or five years after the last request for the enforceable life of the patent, whichever is longer;
- d) a test of the viability of the biological material at the time of deposit will be conducted (see 37 C.F.R. § 1.807); and

e) the deposit will be replaced if it should ever become inviable.

Therefore, Applicant submits at least 2500 seeds of hybrid maize plant 39W54 and the inbred parents (GE533274 x GE533275) x GE492318 have been deposited with the ATCC. However, Applicant submits in an effort to expedite prosecution claim 33 has now been canceled, thereby alleviating this rejection.

Claims 8-19, 21-32 and 34-40 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification, as stated in the last Office Action for claims 8-19 and 21-32.

Applicant has canceled claims 8-19, 21-32 and 34-40, alleviating this rejection.

Claims 8, 12-19, 21, 25-32 and 34-40 stand rejected under 35 U.S.C. § 112, first paragraph for the reasons stated in the last Office Action for claims 8, 12-19, 21 and 25-32.

Applicant has canceled claims 8, 12-19, 21, 25-32 and 34-40, thereby alleviating this rejection.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections to claims 8-19 and 21-40 under 35 U.S.C. § 112, first paragraph.

Summary

Applicant acknowledges that claims 1-7, 20, and 41 are allowed.

Applicant further acknowledges that claims 1-10, 12-14, 16-18, 20-23, 25-27 and 29-31 remain free of the prior art. In addition the Examiner states the prior art fails to teach or fairly suggest plants which derive 50% or more of their alleles from the exemplified hybrid. Applicant submits that this clearly indicates that hybrid maize plant 39W54 as a whole is considered to be distinguishable from the prior art for the purposes of novelty and non-obviousness. Therefore, Applicant respectfully submits that the deposit of the representative seed of 39W54 and inbred parents (GE533274 x GE533275) x GE492318 should satisfy the description requirement. In light of the above, Applicant respectfully submits that the rejections under 35 U.S.C. § 112, first paragraph, are improper and requests reconsideration and withdrawal of these rejections.

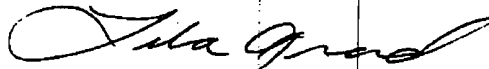
Conclusion

In conclusion, Applicant submits in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested.

No additional fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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